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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-816,529	03/23/2001	Paul G. Clemmer	30-4336 (4510)	8030

7590)

08/04/2003

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EXAMINER

MANOHARAN, VIRGINIA

ART UNIT

PAPER NUMBER

1764

11

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,529

Applicant(s)

CLEMMER, PAUL G.

Examiner

Virginia Manoharan

Art Unit

1764

my-11

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Prior for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims 4 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The claimed "recovered difluoromethane" in claims 8-9 lack antecedent support. The term "recovered" should be replaced with -purified—as being recovered is not initially recited in the claims.
- b. In claims 4 and 8-9, the phrase—at least one—should be inserted before-impurity—for consistent used of terminology in the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '660 in view of Coulson et al publication and Yokoyama et al.

The above references are applied for the same combined reasons as set forth at the paragraph bridging pages 3 and 4.

Applicant's arguments filed May 5, 2003 have been fully considered but they are not persuasive.

Applicants following arguments such as: "The cited prior art is devoid of any teaching or suggestion of the claimed invention. First, there is no suggestion in WO 9907660 of recycling at least a portion of the extractive agent stream to the fluorination

process. To the contrary, the distillation approach in WO 9907660 is independent from the fluorination process. This is not surprising given the fact that most of the extractives disclosed in WO 9907660 are not reactants in the preparation of the desired fluorinated product. Indeed, the uniqueness of methylene chloride as being both an extractive and a reactant was apparently overlooked .." are not persuasive of patentability for the following reasons:

Firstly, it is noted that applicants' recognizes the used of the same extractive agent i.e., methylene chloride in the prior art as in the claimed invention. This is evident at page 6 of the REMARKS where applicant stipulates that "...applicant wishes to point out that WO 9907660 does indeed disclose the use of dichloromethane as an extractive.... Specifically, on page 12, line 9; WO 9907660 states, "representative chlorocarbon extractive agents include methylene chloride.... Methylene chloride and dichloromethane are the same..." Furthermore, the used of dichloromethane as reactant in the fluorination process is well-documented. Thus, while WO '660 does not disclose the argued "recycling at least a portion of the extractive agent stream to the fluorination process...", however, the above limitation is not unobvious nor is it evidence of criticality as taught by Yokoyama. That is, Yokoyama at col. 2, lines 5-9, suggests that "the extractants to be used in the present invention, are the starting material and the intermediate for difluoromethane, and the extractants dissolved in HF can be converted to difluoromethane as the desire product, by returning them to the reaction system. Applicant is arguing the references individually where the rejection is based on a combination of references. Moreover, the claims are not limited to

controlling the amount of extractive being recycled to the fluorination process and controlling the flow rates so as to optimize the fluorination and distillation process. commensurate with the arguments. Also, the arguments relative to the "side stream" and "bottom stream" are not considered well—taken. These streams are not even recited in the independent claim, and therefore must not be important to applicant's invention.

Thus, in the absence of anything, which may be "new" or "unexpected result", a prima facie case of obviousness has been established by the art and has not been rebutted.

Unexpected results must be established by factual evidence. Mere arguments or conclusory statements in the specification appellants' amendments, or the Brief do not suffice. In Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972). In re Wood, 582, F.2d 638, 199 USPQ 137, 140 (CCPA 1978).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claims 12-19 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Manoharan whose telephone number is (703) 308-3844. The examiner can normally be reached on Tuesday--Friday from 7:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9311 for regular communications and (703) 308-0651 for After Final communications.



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